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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|------------------------|----------------------|
| 10/764,233 | 01/23/2004 | Neeraj Gaur | 2003P04916US01 | 8462 |
| 7590 | 02/10/2006 | | EXAMINER [REDACTED] | CAI, WAYNE HUU |
| Siemens Corporation Attn: Elsa Keller, Legal Administrator Intellectual Property Department 170 Wood Avenue South Iselin, NJ 08830 | | | ART UNIT [REDACTED] | PAPER NUMBER 2681 |

DATE MAILED: 02/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|------------------------------|------------------------|---------------------|--|
| | 10/764,233 | GAUR, NEERAJ | |
| Examiner | Art Unit | | |
| Wayne Cai | 2681 | | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 23 January 2004.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-20 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 23 January 2004 is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. ____;
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 01/23/2004.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
5) Notice of Informal Patent Application (PTO-152)
6) Other: ____.

DETAILED ACTION

Double Patenting

1. **Claims 16-20** are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 11-15. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The Examiner is confused by the statement "**providing said unencrypted content upon said mobile device** when said specific removable data card containing decryption information for said encrypted content is detected within said mobile device." The Examiner believes it should state that **providing said encrypted content for said mobile device** when specific removable data containing decryption information for said encrypted content is detected within said mobile device.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 1 recites the limitation "said unencrypted" in line 10. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 3-5, and 7-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Bremer (US 2003/0174838 A1).

Regarding claim 1, Bremer discloses a method for providing authorized access of copy-protected content to an authorized user of a mobile device, comprising:

- receiving content (paragraph 0030, i.e., the second terminal 14 receives content that is forwarded by the first terminal 12);
- encrypting said content, said encrypted content being stored in memory of a mobile device (paragraph 0030 teaches the first terminal 12 encrypts the

protected content and inherently the protected content is stored in a memory of the terminal);

- generating decryption information for said encrypted content; said decryption information being stored within specific removable data card (see paragraph 0056) within said mobile device (paragraphs 0033-0034, and 0046);
- providing said unencrypted content upon said mobile device when said specific removable data card containing decryption information for said encrypted content is detected within said mobile device (paragraph 0035).

Regarding claim 3, Bremer discloses the method as described in claim 1 as described above. Bremer also discloses wherein decryption information (i.e., a private key of the second terminal 14) of said encrypted content is stored in a secure location of said specific removable data card.

Regarding claim 4, Bremer discloses the method as described in claim 1 as described above. Bremer further discloses said specific removable data card being at least one of a subscriber identity module card and a removable user interface module card (paragraph 0056).

Regarding claim 5, Bremer discloses a method of providing copy-protected content to a mobile device, comprising:

- transferring content to a mobile device (i.e., the first terminal 12 forwards content to the second terminal 14)), said content being in an encrypted format (paragraph 0030);

- transferring digital rights information (i.e., includes a device certificate of the terminal 12) for decrypting the content to said mobile device, said digital rights information being stored within a specific removable data card within said mobile device (paragraph 0034);
- wherein the content in said encrypted format is able to be decrypted upon the detection of the specific removable data card containing said digital rights information (paragraph 0049).

Regarding claim 7, Bremer discloses the method as described in claim 5 as described above. Bremer also discloses wherein said digital rights information (i.e., the device certificate) for decrypting content is stored in a secure location of said specific removable data card (paragraphs 0034, and 0056).

Regarding claims 8, and 9, Bremer discloses the method as described in claim 5 as described above. Bremer further discloses wherein the mobile device is a mobile telephone (see fig. 1), and wherein said removable data card is at least one of a subscriber identity module card and a removable user interface module card (paragraph 0056).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bremer

Regarding claims 2, and 6, Bremer discloses the method as described in claim 1 as described above, except for preventing decryption of said encrypted content when a different removable data card is inserted within said mobile device.

However, it is obvious to one skilled in the art that when a different removable data card is inserted, then the content would not be able to decrypt the encrypted content because the removable data card does not have the same decryption information

10. Claims 10-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bremer in view of Tarpenning et al. (hereinafter "Tarpenning") (US 6,513,117 B2).

Regarding claim 10, Bremer discloses the method as described in claim 5 as described above, except for wherein said content transferring step comprises downloading said content over-the-air or downloading said content via a computer coupled to said mobile device.

In a similar endeavor, Tarpenning discloses a certificate handling for digital rights management system. Tarpenning further discloses wherein said content transferring step comprises downloading said content over-the-air or downloading said content via a computer coupled to said mobile device (col. 4, lines 15-31).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the step of downloading said content so that the information could be transferred from one device to another device.

Regarding claims 11, and 16, Bremer discloses a method, in a system including a first mobile device and a second mobile device, for maintaining copy-protected content, comprising:

- transferring encrypted content stored within said first mobile device to said second mobile device (fig. 1, elements 12 & 14).

Bremer, fails to disclose:

- transferring a specific removable data card including digital rights information associated with said first mobile device to a receptacle of said second mobile device;
- decrypting said encrypted content transferred from said first mobile device on said second mobile device when said specific removable data card including said digital rights information has been detected within said second mobile device.

In a similar endeavor, Tarpenning discloses a certificate handling for digital rights management system. Tarpenning further discloses:

- transferring digital rights information associated with said first mobile device to a receptacle of said second mobile device (fig. 5, element 1045 and its descriptions);

- decrypting said encrypted content transferred from said first mobile device on said second mobile device when said digital rights information has been detected within said second mobile device (col. 8, lines 45-58).

The Examiner also notes that even though neither Bremer nor Tarpenning specifically discloses transferring a specific removable data card. However, Bremer does teach that some device certificates could be stored on the SIM card (i.e., a specific removable data card) as well as private key storage and operations (see Bremer, paragraph 0056). On the other hand, Tarpenning teaches transferring digital rights information from the first device to the second device. The Examiner further notes that this digital rights information must be stored in a secure place of a memory. Therefore, it would have been obvious to one skilled in the art to modify both Bremer, and Tarpenning's invention to arrive at the present invention by storing the digital rights information on the removable data card.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the steps of transferring the digital rights information associated with the first mobile device to the second mobile device because it adds a flexibility for user to upgrade to a newer model of the mobile device without incurring costs to re-acquire the rights. In addition, the owner of the protected information still gets protections at the same time.

Regarding claims 12, and 17, Bremer and Tarpenning disclose the method as described in claims 11, and 16 as described above. Tarpenning further discloses

preventing decryption of said content when the User Certificate is not installed, or detected within said second mobile device (col. 8, lines 45-58).

Regarding claims 13, and 18, Bremer and Tarpenning disclose the method as described in claims 11, and 16 as described above. Neither Bremer nor Tarpenning specifically teaches wherein transferring encrypted content includes removing a removable media disk storing encrypted content from said first mobile device and inserting the removable media disk into the second mobile device.

However, it is obvious to one skilled in the art that the claim feature is not novel because it is known that the content could be stored on the removable data card (i.e., SIM card). Therefore, by removing the removable data card that is stored an encrypted content from one mobile device to another device is not novel.

Regarding claims 14-15, and 19-20, Bremer and Tarpenning both disclose the method as described in claims 11, and 16 as described above. Bremer also discloses wherein the mobile device is a mobile telephone, a mobile handset, a personal digital assistant (PDA), or pager (fig. 1), and wherein said specific removable data card is at least one of a subscriber identity module card and a removable user interface module card (paragraph 0056).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Nordenstam et al. (US 6,711,263 B1)

Asokan et al. (US 2003/00226012 A1)

Newman (US 2003/0229797 A1)

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wayne Cai whose telephone number is (571) 272-7798. The examiner can normally be reached on Monday-Friday; 9:00-6:00; alternating Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wayne Cai
Examiner
Art Unit 2681


ERIKA A. GARY
PRIMARY EXAMINER